

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed October 20, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Objections**

Claim 5 has been objected to for containing an informality. In response to the objection, Applicant has amended claim 5 to correct the informality. In view of that claim amendment, Applicant respectfully submits that claim 5 is not objectionable and respectfully requests that the objection be withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1, 2, 3, 5-8, 10-16, 18, and 20-29 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Iida (U.S. Pat. No. 6,900,903). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Iida reference. Applicant discusses the Iida reference and Applicant’s claims in the following.

#### A. The Iida Disclosure

Iida discloses a network facsimile apparatus. Iida, Patent Title. The facsimile apparatus comprises a server section 12 that performs communications with a browser of a client machine. Iida, column 4, lines 15-17.

Iida describes operation of the facsimile apparatus in columns 5 and 6. More particularly, Iida describes two processes in which the facsimile apparatus transmits a fax for a client. Beginning with the first process, a client machine accesses the facsimile apparatus with a browser and, in response, receives homepage data of the facsimile apparatus. Iida, column 6, lines 10-17. The user then selects an object file on a further page 602 presented in the browser and pushes a “send” button. Iida, column 6, lines 22-23. However, Applicant notes that the object files are listed in a “fax reception list page” (see Iida, Figure 8), meaning the object files are documents that have been *received by and are resident on the facsimile apparatus*. Support for this fact is contained in column 6, which describes a *different* transmission scenario comprising “the case where the network facsimile apparatus transmits a document file stored at a client machine.” Iida, column 6, lines 33-35. Therefore, in the first transmission process, a browser is only used to fax a file stored on the facsimile apparatus.

In the second transmission process, a document stored on the client machine is transmitted. Iida, column 6, lines 33-35. In this process, the user of a client machine opens a document using a word processor application. Iida, column 6, lines 35-38. Next, the user simply designates the facsimile apparatus as a printer and selects print. Iida, column 6, lines 38-39. The facsimile apparatus then receives the document, converts it to a TIFF file, and

transmits it to a recipient. Iida, column 6, lines 40-58. Accordingly, in this embodiment, *no* “browser” is used in the transmission process.

## **B. Applicant’s Claims**

As is noted above, Iida fails to teach several of Applicant’s claim limitations. Applicant discusses some of those claim limitations in the following.

### **1. Claims 1-3, 5-8, and 20-24**

Applicant’s claim 1 provides as follows (emphasis added):

1. A method practiced by a faxing device *for faxing a document stored on a user computing device*, comprising:
  - receiving a fax request from a network browser executing on the user computing device;
  - uploading content from the faxing device to the network browser;*
  - receiving a fax job from the network browser; and
  - transmitting the document stored on the user computing device as a facsimile from the faxing device to a recipient device.*

Regarding claim 1, Iida does not teach a method for faxing a document “stored on a user computing device” that comprises “uploading content from the faxing device to the network browser” and then “transmitting the document stored on the user computing device as a facsimile from the faxing device”. As is described above, Iida only describes two facsimile transmission processes. In the first process, an “object file” stored on Iida’s facsimile apparatus is transmitted. Therefore, in that process, no method for “faxing a

document stored on a user computing device” is described. As for the second process, a user sends a document to Iida’s facsimile apparatus by designating the facsimile apparatus as the “printer” and selecting a print command from a word processor application. Therefore, in that process, no content is uploaded to the user’s browser in the transmission process. In view of the above, Iida does not teach the method recited in claim 1. Applicant therefore requests that the rejection be withdrawn as to claim 1 and its dependents.

With particular regard to dependent claim 3, Iida certainly does not teach “uploading at least one application that is configured to perform a designated task on the user computing device”. Column 5, lines 33-41 of the Iida reference, which were identified in the Office Action, do not disclose such a process. In particular, that portion of the Iida disclosure provides as follows:

At ST402, the client machine connected to a network starts a WWW browser (homepage browsing software) and enters the URL address of the network facsimile apparatus to access the homepage. In the accessed network facsimile apparatus, at ST 403, WWW server sections 12 initiates the processing through network control section 10, and transmits homepage data (HTML file) stored in an external storage to the WWW browser of the client machine.

[Iida, column 5, lines 33-41]

In view of the above, Iida only discloses uploading a home page to the client machine, *not* an “application” that is configured to perform a designated task on the computing device.

Moreover, regarding dependent claim 5, Iida does not teach that the uploaded application is configured to “retrieve a selected file, translate it, and transmit the translated file back to the faxing device”. Simply stated, Iida fails to mention anything of the sort.

## **2. Claims 10-12, 25, and 26**

Applicant’s claim 10 provides as follows (emphasis added):

10. A system comprised by a faxing device *for faxing a document stored on a user computing device*, comprising:

means for receiving a fax request from a network browser executed on the user computing device;

*means for uploading content from the faxing device to the network browser;*

means for receiving a fax job from the network browser; and

*means for transmitting the document stored on the user computing device from the faxing device a facsimile to a recipient device.*

Regarding claim 10, Iida does not teach a system “for faxing a document stored on a user computing device” that comprises “means for uploading content from the faxing device to the network browser” and “means for transmitting the document stored on the user computing device from the faxing device a facsimile to a recipient device”, at least for reasons described above in relation to claim 1. Accordingly, Applicant submits that the rejection should be withdrawn as to claim 10 and its dependents.

Regarding dependent claim 12, Iida does not teach “means for uploading at least one application that is configured to perform a designated task on the user computing device”, at least for reasons described above in relation to claim 3.

### **3. Claims 13-15, 27, and 28**

Applicant’s claim 13 provides as follows (emphasis added):

13. A system stored on a computer readable medium of a faxing device, comprising:

logic configured to receive a fax request from a network browser executed on a user computing device;

*logic configured to upload content from the faxing device to the network browser;*

logic configured to receive a fax job from the network browser;  
and

*logic configured to transmit a document stored on the user computing device from the faxing device a facsimile to a recipient device.*

Regarding claim 13, Iida does not teach a system comprising “logic configured to upload content from the faxing device to the network browser” and “logic configured to transmit a document stored on the user computing device from the faxing device a facsimile to a recipient device”, at least for reasons described above in relation to claim 1. Accordingly, Applicant requests that the rejection against claim 13 and its dependents be withdrawn.

Regarding dependent claim 15, Iida does not teach “logic configured to upload at least one application that is configured to perform a designated task on the user computing device”, at least for reasons described above in relation to claim 3.

#### **4. Claims 16, 18, and 29**

Applicant’s claim 16 provides as follows (emphasis added):

16. A faxing device, comprising:  
a processing device;  
faxing hardware; and  
memory comprising a fax control module and an embedded server,  
the fax control module including logic for generating at least one control  
screen that can be uploaded to a network browser of a user computing  
device and *at least one application that can also be uploaded to the  
network browser, the at least one application further being configured to  
facilitate faxing of a document stored on a the computing device by the  
faxing device.*

Regarding claim 16, Iida does not teach a faxing device comprising a fax control module including an application that can be “uploaded to the network browser” the application being configured to “facilitate faxing of a document stored on the computing device by the faxing device”. Simply stated, Iida does not anticipate uploading any applications to a user browser, whether they be for facilitating faxing or performing some other action. For at least this reason, Iida does not anticipate claim 16 or its dependents.

Regarding dependent claim 18, Iida does not teach an uploaded application that is “configured to retrieve a selected file, translate it, and transmit the translated file back to the faxing device”, at least for reasons described in relation to claim 5.

### **C. Conclusion**

Due to the shortcomings of the Iida reference described in the foregoing, Applicant respectfully asserts that Iida does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 4, 9, 17, and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida. Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one



of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

As is identified above, Iida does not teach several aspects of Applicant's claims. Applicant submits that claims 4, 9, 17, and 19 are allowable over the Iida for at least the same reasons that claims 1 and 16 are allowable.

In the Office Action, the Examiner states the following: "the tasks of determining the contents of a hard disk, uploading a confirmation notice to the user browser and having one application comprising of a java applet are well known and routinely implemented in the art." Accordingly, the Examiner is, in essence, taking official notice of the limitations contained in claims 4, 9, 17, and 19.

The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088,

1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner’s assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

In the instant case, Applicant submits that the limitations contained in claims 4, 9, 17, and 19 were not so well-known as to be capable of “instant and unquestionable demonstration. “ More particularly, Applicant asserts that uploading an application *from a faxing device to a browser to determine the contents of a hard disk of the computing device that executes the browser* was clearly not “well-known” at the time Applicant’s application was filed. Furthermore, Applicant asserts that uploading a *Java applet from a faxing device to a browser to determine the contents of a hard disk of the computing device that executes the browser* was clearly not “well-known” at the time Applicant’s application was filed. It is readily apparent that the Examiner is merely evaluating each limitation in Applicant’s dependent claims without regard for the other limitations contained in the claims from which the dependent claims depend. As is well established in the law, the Examiner must instead consider the claims *as a whole*. *Hartness International, Inc. v. Simplicatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed.

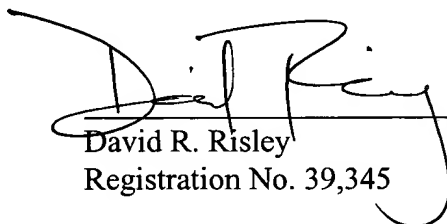
Cir. 1987)(In determining obviousness, “the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). In the present case, the Examiner is stating that, in general, uploading applications such as Java applets to browsers was well-known. Irrespective of whether this is or is not true, such analysis ignores the fact that Applicant’s claims describe such uploading *from a faxing device*. Such operation was not well-known at the time of Applicant’s invention.

In view of the above, Applicant traverses the Examiner’s use of official notice. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
David R. Risley  
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

11-21-05  
Mary Meehan  
Signature